

### **REMARKS**

Applicants appreciate the Examiner's thorough examination of the application and request reexamination and reconsideration of the application in view of the following remarks.

As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03. Applicants respectfully request reconsideration of the present application in view of the following remarks.

Preliminarily, Applicants note that a thorough review of the Applicants' Amendment After Final Action filed on July 11, 2008 contained an error. Specifically, in preparing the amendments to the claims in the Amendment After Final Action, the word "cancellation" was inadvertently changed to "validation" at lines 2 and 5 of claim 6. This was not an amendment to the claim, but merely an error in transcribing the claim for the Amendment After Final Action. Accordingly, Applicants have corrected this mistake such that claim 6 as shown above is accurately presented.

### **Specification**

The Examiner maintained the objection to the specification under 37 C.F.R. § 1.71, as being so incomprehensible as to preclude a reasonable search of the prior art by the Examiner. Applicants respectfully traverse the objection.

Applicants direct the Examiner's attention to Fig. 2 and paragraphs [0108] – [0130] of the subject application, which describe in detail the claimed method. Paragraph [0130] provides a brief but clear summary of the claimed method that may aid in the Examiner's understanding of the

claimed method. Accordingly, reconsideration and withdrawal of this objection is respectfully requested. If the Examiner still has questions with regard to the specification, the undersigned is available to discuss same as suggested by the Examiner.

**Claim Rejections – 35 U.S.C. § 103**

Claims 1-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Postrel (U.S. Publication No. 2007/0130011) in view of Laurent et al. (U.S. Patent No. 7,206,769) and O'Leary et al. (U.S. Patent No. 6,609,113).

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Independent claim 1 is directed to an electronic settlement apparatus connected to terminals via a network, said apparatus comprising a memory for storing first point data, wherein the first point data is representative of points given to a first user, and a processor, wherein said processor obtains, from any of said terminals, transferor specification data that specifies a first user, transferee specification data that specifies a second user, and transfer amount data representing points to be transferred to an account associated with said second user from an account associated with said first user, updates the first point data of said first user in such a way that the points specified by said first point data are reduced by points designated by said obtained transfer amount data, generates a second point data representing an amount of points given to said second user, generates invalidation data representative of an amount of points within the account associated with the second user for prohibiting said second user from using the points specified by said second point data, stores second point data and said invalidation data onto said memory, generates validation data for validating the points specified by the second point data associated with said invalidation data, transmits said generated validation data to a supply source terminal of said transferor specification data, and, when receiving said validation data from one of said terminals, modifies or deletes said invalidation data, enabling said points specified by said second point data associated with said invalidation data, to be used by said second user. (emphasis added)

The Examiner alleged that Postrel discloses all of the features of independent claim 1 except for a processor that generates a second point data representing an amount of points given to the second user; generated invalidation data representative of an amount of points within the account associated with the first user for prohibiting the second user from using the points specified by the second point data; stores the invalidation data onto the memory; and generated validation data for validating the points specified by the second point data associated with the invalidation data.

The Examiner further alleged that Laurent discloses generating validation data for validating the points specified by the second point data associated with the invalidation data and that O'Leary discloses generating a second point data representing an amount of points given to the second user.

As noted above, independent claim 1 includes a processor that generates a second point data representing an amount of points given to said second user and which generates invalidation data representative of an amount of points within the account associated with the second user for prohibiting said second user from using the points specified by said second point data. The Examiner admits that at least the cited recitations of independent claim 1 are not disclosed by Postrel. Laurent also fails to disclose these features of independent claim 1.

Laurent is directed to an electronic wallet system, which enables the transfer of tokens between electronic wallets. Laurent discloses that when a user A desires to transfer tokens to another purse, the user inserts his smart card in a client and choosing the application for transferring tokens to another purse. The client sends a request to the server, and the server sends back a list of all registered purses that can receive tokens. The user then selects the recipient of the token transfer and the amount of tokens to be transferred and a message is sent to the server including the action to be completed (the transfer of tokens), the sender's identifier, and the recipient's identifier. The server then adds this action to the recipient's purse. When the recipient inserts his smart card into a client, the server retrieves the action corresponding to the recipient's purse and verifies that the recipient's purse identifier matches the purse identifier attached to the action. Then the server executes the action and deposits the tokens into the recipient's purse. See Col 6, line 34 – Col 7, line 27 of Laurent. Laurent also discloses select security features such as smart card authorization, purse registration, and protection of messages between a client and the server, which are provided to the

electronic wallet system and must be cleared before the tokens can be transferred to the recipient. Col 7, lines 32-62 and Col 8, line 4 – Col 12, line 49 of Laurent.

Claim 1 of the subject application includes a processor that “generates a second point data representing an amount of points given to said second user” (emphasis added) and which “generates invalidation data representative of an amount of points within the account associated with the second user for prohibiting said second user from using the points specified by said second point data.” (emphasis added). Thus, the points are transferred to the second user, and then are invalidated, prohibiting the second user from using the points. As noted above, Laurent discloses the use of security features before the tokens are transferred to the recipient, which is contrary to claim 1 of the subject application.

Accordingly, Laurent fails to disclose a processor that generates a second point data representing an amount of points given to said second user and which generates invalidation data representative of an amount of points within the account associated with the second user for prohibiting said second user from using the points specified by said second point data as claimed in claim 1 of the subject application.

Further, O’Leary also fails to disclose a processor that generates a second point data representing an amount of points given to said second user and which generates invalidation data representative of an amount of points within the account associated with the second user for prohibiting said second user from using the points specified by said second point data as claimed in claim 1 of the subject application. O’Leary is directed to a method and system for processing internet payments using the electronic funds transfer network and discloses that “[o]nce the financial loop has been closed with the receipt of the payment record 245 by the merchant, the merchant can confidently ship the goods 260 to the consumer.” Col 17, lines 58-61 of O’Leary. O’Leary discloses shipping the goods upon receipt of payment, and fails to disclose anything which would prohibit the merchant from using the received payment. O’Leary clearly does not disclose generating invalidation data representative of an amount of points within the account associated with the second user for prohibiting said second user from using the points specified by said second point data as claimed by the Applicants.

Accordingly, as all of the cited references fail to disclose a processor that generates a second point data representing an amount of points given to said second user and which generates invalidation data representative of an amount of points within the account associated with the second user for prohibiting said second user from using the points specified by said second point data as claimed by Applicants, the combination of references fails to teach or suggest all of the elements of independent claim 1, and thus fails to render claim 1 obvious. Accordingly, independent claim 1, and dependent claims 2-7 are patentable over the references for at least this reason.

### **Conclusion**

In view of the above remarks, it is respectfully submitted that the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

It is believed that any additional fees due with respect to this paper have already been identified in any transmittal accompanying this paper. However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge our Deposit Account No. 18-0013, under Order No. 65316-0007 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

Dated: March 16, 2009

Respectfully submitted,

Electronic signature: /Jason D. Shanske/  
Jason D. Shanske  
Registration No.: 43,915  
Michael B. Stewart  
Registration No.: 36,018  
RADER, FISHMAN & GRAUER PLLC  
Correspondence Customer Number: 10291  
Attorneys for Applicant